

Application No. 10/069,026
Amdt. dated November 19, 2004
Reply to Office Action of May 20, 2004

REMARKS/ARGUMENTS

In the Office Action dated May 20, 2004, the Examiner has rejected the subject matter of Claims 1-4 and 10-17 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,919,414 to Dobler. The Examiner has also rejected subject matter of Claim 5, 6, 18 and 19 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,919,414 to Dobler. The reference and the Examiner's rejection of the claims are discussed below.

The Examiner has objected to the specification and has requested that references to specific claim numbers be deleted. The Examiner also contends that the application does not contain an Abstract of the Disclosure as required under 37 C.F.R. §1.72(b).

Claims 8 and 9 have been objected to under 37 C.F.R. §1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. The Examiner contends that Claims 8 and 9 recite the same limitations as Claim 7.

The Examiner has rejected claims 1-19 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particular point out and distinctly claim the subject matter which Applicant regards as the invention.

In response to the rejections, Applicant has undertaken to amend the specification to delete references to specific claim numbers. Applicant has amended the specification to include the claim language of the original claims referred to by the claim numbers. Claims 1, 11, 14-16, 18 and 19 have been amended to address the rejections under 35 U.S.C. §112. Applicant avers that the amendments to the specification and claims were not motivated by the prior art and that no new matter has been added.

Applicant submits that an Abstract of the Disclosure was originally filed with the application on February 19, 2002 with the original filing of the application. An Abstract of the Disclosure was submitted and is shown on the copy of the PCT publication WO 01/17744

Application No. 10/069,026
Amdt. dated November 19, 2004
Reply to Office Action of May 20, 2004

A1 cover page. However, for the Examiner's ease of review, Applicant submits a copy of the original Abstract of the Disclosure on page 2 of this response. Applicant avers that no new matter has been added.

Applicant submits that Claims 8 and 9 do not fail to further limit the subject matter of the previous claim. Claim 8 states that the label forming part is "taken hold of by the carrier". Claim 9 states that the label forming part is "taken hold of by the retaining element". Claims 8 and 9 claim different elements of the apparatus, namely, the "carrier" and the "retaining element". Accordingly, Claims 8 and 9 do not recite the same limitation as Claim 7.

The Examiner has indicated that Claim 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant wishes to thank the Examiner for his indication of allowable subject matter. Accordingly, Applicant has added new Claim 45 which includes the elements of original Claims 1 and 7. Claims 1 and 7 have been cancelled. Applicant has amended Claims 2, 3, 5, 6, 8-10, 14 and 16-18 to properly depend on new Claim 45. Applicant submits that new Claim 47 is in condition for allowance and those claims depending therefrom are also in condition for allowance.

The Examiner has rejected subject matter of claims 1-4 and 10-17 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,919,414 to Dobler. The Examiner contends that Dobler '414 reference discloses a method for manufacturing labels for placement in an injection mold where a web of film is supplied and is placed on a supporting carrier. Part of the web is cut out and a retaining element is supplied to a second side of the cut out web and the cut out web is picked up from the carrier. The Examiner contends that it is inherent that the film web will be printed prior to forming the labels and that the printing will be on the opposite surface. Applicant traverses of the rejection and requests withdrawal based on the following analysis.

Application No. 10/069,026
Amdt. dated November 19, 2004
Reply to Office Action of May 20, 2004

The Dobler '414 reference does not teach or suggest holding a part of a strip of film by a retaining element, and then cutting the part of the strip of film enclosed between a carrier and a retaining element to loosen the part of the strip of film from the strip of film to form a label-forming part as defined in Claim 45. Further the Dobler '414 reference does not teach or suggest that the retaining element forms half of the cutting part when used with the carrier as defined in Claim 45.

The Dobler '414 reference does not teach or suggest a method for manufacturing labels for placement in an injection mold where a strip of film is placed over a supporting carrier overlaying a blanking opening. The Dobler '414 reference does not teach or suggest that a blanking punch is moved in a direction of a retaining element to cut out a portion of the strip of film to form a label using the blanking opening as defined in Claim 11.

The Dobler '414 reference does not teach or suggest that the label-forming part is pulled taut or stretched over the retaining element as defined in Claims 4 and 16.

Accordingly, Applicant respectfully submits that new Claim 45, Claim 11 and those claims depending therefrom patentably distinguish over the cited prior art.

Claims 5, 6, 18 and 19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Dobler '414 reference. The Examiner concedes that the Dobler '414 reference does not teach or suggest taking hold of the label using a static charge or adhesion. The Examiner contends it would have been obvious to one having ordinary skill in the art at the time the invention was made that using static charge or adhesion to take hold of the labels on the retaining element is an obvious matter of design choice wherein no stated problem is solved or an expected result obtained in using static charge or adhesion versus vacuum forced as taught by the Dobler '414 reference as long as the label is held without crease on the retaining element. Regarding Claims 18 and 19, the Examiner contends that that the thickness of the film web lends no patentable weight to the method being claimed, and that

Application No. 10/069,026
Amdt. dated November 19, 2004
Reply to Office Action of May 20, 2004

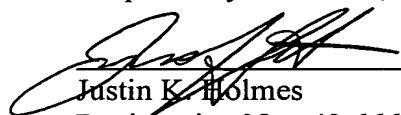
the Dobler '414 reference's method is capable of using film web of that particular thickness. Applicant traverses the rejection and requests withdrawal based on the following analysis.

Applicant submits that the label thicknesses as defined in Claims 18 and 19 would not work with the Dobler '414 reference's method. Specifically, the label thicknesses of 30 micrometers, 20 micrometers, 15 micrometers and 10 micrometers are too thin to be used in the Dobler '414 method and would result in a wrinkled label when put into a mold. The Dobler '414 reference uses an insertion head which moves the label from the retaining element to the mold and can wrinkle the label in the process. To the contrary, the present invention as defined in the claims would not result in a wrinkled label when put into a mold, since the label is held by the retaining element and placed in the mold and does not use an insertion head.

Applicant submits that in view of the reasons set forth earlier regarding the earlier rejection of Claims 45 and 11, that Claims 5, 6, 18 and 19 and those claims depending therefrom patentably distinguish over the cited prior art.

In view therefore of the amendments to the specification and claims as well as the remarks set forth above, Applicant firmly believes the present application is in all respects in condition for allowance which actually is earnestly solicited.

Respectfully submitted,



Justin K. Holmes
Registration No.: 42,666
Attorney for Applicant

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550
JKH/me/mf

197121_1